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10/551,660

11/29/2006

Patrick E. Snow

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EXAMINER

KHAN, MEHMOOD B

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,660	<b>Applicant(s)</b> SNOW, PATRICK E.	
	<b>Examiner</b> MEHMOOD B. KHAN	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/20/2007 &amp; 12/18/2006</u> .                              | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005) Section IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The new IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F. 3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F. 3d at

1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory to a data structure per se held nonstatutory.)

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F. 3d at 1583-84, 32 USPQ2d at 103

Claims 34-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34-36 define computer program product embodying functional descriptive material and computer code. However, the specification does not clearly state the type of a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). That is, the scope of the presently claimed computer program can range from paper on which the program is written, to a program simply contemplated or memorized by a person. The examiner suggests amending the claim to embody the program on "A computer readable medium encoded with computer executable instructions, the instructions comprising" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

The USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (Official Gazette notice of 22 November 2005) Section IV, reads as follows:

While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it has no substantial practical application”).

To satisfy section 101 requirements, the claim must be for a practical application of Sec. 101 judicial exception, which can be identified in various ways:

The claimed invention “transforms” an article or physical object to a different state or thing.

The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 8-15, 18, 25 and 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho (EP 1139684 A1).**

Claims 1, 29 and 31, Cho discloses a method of controlling usage of a portable digital device having one of an audio or an image data recording function **(0001, where Cho discloses inhibition or transmission)**, Cho discloses including inhibiting operation of said digital device when said portable digital device is located in a specific geographic region **(0001, where Cho discloses areas)**.

Claims 2 and 30, Cho discloses wherein at least one fixed location security station and at least one other portable digital device transmits an inhibiting signal intermittently in the specific geographic region **(0001, 0006, where Cho discloses a mode signal generator)**, Cho discloses at least one of the audio or image function of the portable digital device is disabled on receipt of the signal **(0001, where Cho discloses inhibition or transmission)**.

Claim 3, Cho discloses wherein said portable digital device is configured so that when said device is outside the specific geographic region, the function is restored **(0022, where Cho discloses there is no mode signal)**.

Claim 8, Cho discloses steps of storing data relating to said device detected as being present in the specific geographical region **(0016, where Cho discloses a memory)**.

Claim 9, Cho discloses wherein said function is inhibited for a predetermined period of time before the function can be enabled again **(0028, where Cho discloses beginning of events)**.

Claim 10, Cho discloses wherein the device has a memory **(0033, where Cho discloses a memory)**, Cho discloses modifying the memory of the device to indicate that the inhibition operation has occurred, checking whether the memory has been modified to indicate that the inhibition operation has occurred before allowing access to the data recording function **(0033, where Cho discloses inhibition)**.

Claim 11, Cho discloses wherein the inhibition operation is communicated to the portable digital device by means of a signal transmitted over at least one radio frequency **(0027, where Cho discloses transmission frequencies)**,

Cho does not explicitly disclose selected from the group supported by GSM, GPRS, 3G, I-Mode, UTMS, Ultrawideband (UWB) wireless data standard and/or CDMA. Official notice is taken on the type of communication networks, since it would have been obvious to one of ordinary skill in the art at the time the invention was made that a 2G or 3G network could be used to inhibit operation of devices.

Claim 12, Cho discloses [a method according to claim 11,] Cho discloses wherein at least one frequency used to transmit the signal is changed at intervals to improve security **(0005, where Cho discloses changing intervals)**.

Claim 13, Cho discloses wherein the inhibition operation is communicated to the portable digital device by means of a signal transmitted in the form of one of an audio signal or a signal transmitted at an optical frequency **(0048, where Cho discloses infrared and acoustic waves)**.

Claim 14, Cho discloses a step of installing code on the device for performing the control of usage of the device **(0033, 0034, where Cho discloses codes)**.

Claim 15, Cho discloses wherein the usage control code is installed in a memory within the device **(0033, 0034, where Cho discloses codes and memory)**.



Claim 18, Cho discloses detecting attempted operation of said data recording function when said portable digital device is located in the specific geographic region, and preventing a normal store operation relating to the captured data **(0021, where Cho discloses input of digital data)**.

Claim 25, Cho discloses a method of controlling usage of a portable digital device having a data recording function **(0001)**, Cho discloses detecting operation of said data recording function, and preventing one of a normal store operation **(0021, where Cho discloses inhibiting data storage)**.

Claim 32, Cho discloses enabling operation of said data recording function when said portable digital device is located outside a predetermined geographic region **(0033, where Cho discloses leaving the area)**.

Claim 33, Cho discloses enabling operation of said imaging function in response to an interrogation or enabling signal from a central station **(0033, where Cho discloses leaving the area)**.

Claims 34 and 36, as analyzed with respect to the limitations as discussed in claim 33.

Claim 35, as analyzed with respect to the limitations as discussed in claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Cho in view of Heiskari et al. (US 5,901,342 herein Heiskari).**

Cho does not explicitly disclose wherein at least one portable device is used as a repeater to broaden coverage.

In an analogous art, Heiskari discloses at least one portable device is used as a repeater to broaden coverage **(Col 4: 64-64, where discloses using phones as repeaters)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include using phones as repeaters as taught by Heiskari so as to transmission at fixed states **(Col 2: 60)**.

**Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Cho in view of Fomukong (US 2008/0051105).**

Claim 5, Cho discloses Cho discloses inhibiting operation of said function when said portable digital device is in the specific geographic region **(0001, 0006, where Cho discloses inhibiting operation)**.

Cho does not explicitly disclose monitoring the geographic region of the portable digital device comparing the monitored region with a specific geographical region.

In an analogous art, Fomukong discloses monitoring the geographic region of the portable digital device comparing the monitored region with a specific geographical region **(Claim 3)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include monitoring of mobile phones as taught by Fomukong so as to providing secured and accessible remote receiving unit position information **(0005)**.

Claim 6, Cho does not explicitly disclose wherein the geographic region of the device is monitored by a navigation module selected from the group: GPS.

In an analogous art, Fomukong discloses GPS **(0027, where Fomukong discloses GPS)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include monitoring of mobile phones as taught by Fomukong so as to providing secured and accessible remote receiving unit position information **(0005)**.

Claim 7, Cho does not explicitly disclose wherein the geographic location of the device is monitored by triangulation of signals from at least two cellular base stations.

In an analogous art, Fomukong discloses wherein the geographic location of the device is monitored by triangulation of signals from at least two cellular base stations **(0028, where Fomukong discloses earth based stations)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Cho to include monitoring of mobile phones as taught by Fomukong so as to providing secured and accessible remote receiving unit position information **(0005)**.

**Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Aerrabotu (US 6,829,429).**

Cho does not explicitly disclose a step of modifying code within the device relating to the data recording function and preventing said code being executed by the device.

In an analogous art, Aerrabotu discloses a step of modifying code within the device preventing said code being executed by the device **(Claim 9)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include modifying code as taught by Aerrabotu so as to provide an improved and convenient method for releasing service locks **(Col 1: 44-45)**.

**Claims 17, 19-22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Cocita (US 2006/0281450).**

Claims 17 and 28, Cho discloses detecting disconnection of the device from a communications network **(0044, where Cho discloses leaving the area)**.

Cho does not explicitly discloses preventing a normal transmission operation relating to captured data upon said disconnection.

In an analogous art, Cocita discloses preventing a normal transmission operation relating to captured data upon said disconnection **(0026, where Cocita discloses that**

**is well known to delete data**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include erasing data as taught by Cocita so as to provide safeguarding data **(0009)**.

Claim 19, Cho does not explicitly disclose a step of deleting the captured data from the device.

In an analogous art, Cocita discloses a step of deleting the captured data from the device **(0019, where Cocita discloses erasing all data)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include erasing data as taught by Cocita so as to provide safeguarding data **(0009)**.

Claim 20, Cho in view Cocita does not explicitly disclose a step of transmitting the captured data relating to the device to a security entity.

In an analogous art, Hirai discloses a step of transmitting the captured data relating to the device to a security entity **(Fig. 3A, where Hirai discloses transmission to the monitoring station)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho in view of Cocita to include transmission to a monitor as taught by Hirai so as to copyright protection.

Claim 21, Cho discloses a step of broadcasting a source-identifying signal to the specific geographical region **(0001, 0006, where Cho discloses transmission in an area)**.

Claim 22, Cho discloses wherein the source-identifying signal comprises one of an audio tone or a series of optical signals **(0048, where Cho discloses infrared and acoustic waves)**.

**Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Cocita in view of Hirai (US 2001/0018742).**

Cho in view of Cocita does not explicitly disclose checking if data transmitted over a network includes a recording of the source-identifying signal, and transmitting the data to a security entity instead of its intended recipient.

In an analogous art, Hirai discloses checking if data transmitted over a network includes a recording of the source-identifying signal, and transmitting the data to a security entity instead of its intended recipient **(Fig. 3A)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho in view of Cocita to include transmission to a monitor as taught by Hirai so as to provide copyright protection.

**Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of da Silva (US 6,496,703).**

Cho discloses said security station broadcasting/transmitting an inhibiting or disabling signal intermittently in the specific geographic region **(0001, 0006, where Cho discloses inhibiting operation)** on board the vehicle, Cho discloses at least one function of the portable digital device being disabled on receipt of the signal **(0001, 0006)**.

Cho does not explicitly disclose a vehicle.

In an analogous art, da Silva discloses a vehicle **(Fig. 7)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include vehicles as taught by da Silva so as to prevent interruption of the operation of communication equipment **(Col 1: 44-46)**.

**Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Hirai.**

Cho discloses broadcasting a source-identifying signal to a specific geographical region **(0001, 0006, where Cho discloses transmission and an area)**, Cho discloses detecting attempted transmission of data **(0006, where Cho discloses inhibiting a transmission mode)**.

Cho does not explicitly disclose preventing the attempted transmission of data including the source-identifying signal.

In an analogous art, Hirai discloses preventing the attempted transmission of data including the source-identifying signal **(Fig. 3A, where Hirai discloses transmission to a monitoring station)**. Therefore, it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify Cho to include transmission to a monitor as taught by Hirai so as to provide copyright protection.

**Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho in view of Zellner et al. (US 2006/0105784).**

Cho discloses storing data relating to devices detected as being present in a specific geographical region **(0033, 0034, where Cho discloses storing codes)**.

Cho does not explicitly disclose transmitting marketing data to the devices.

In an analogous art, Zellner discloses transmitting marketing data to the devices **(0007, where Zellner discloses marketing to mobiles)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include marketing to mobiles as taught by Zellner so as to provide location based marketing **(0007)**.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEHMOOD B. KHAN whose telephone number is (571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mehmood B. Khan/  
Examiner, Art Unit 2617

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617